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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,508	07/23/2002	Naoyo Isoda	SIMTEK6265	6620

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EXAMINER

LEWIS, TISHA D

ART UNIT PAPER NUMBER

3681

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,508

Applicant(s)

ISODA ET AL.

Examiner

TISHA D. LEWIS

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 13-20 is/are rejected.
- 7) ☒ Claim(s) 10 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The following is a response to the appeal brief filed on April 5, 2004.

Response to Arguments

Claims 1-20 are pending in the application.

Applicant's arguments, see pages 3-5, filed April 5, 2004, with respect to the rejection(s) of claim(s) 1-5, 7, 8, and 10-16 under 102(b) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of applicant's argument that the reference (Iwata et al) used in the previous prior art rejections does not use shaft variations for engine control.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Toukura ('239). As to claims 1-3, 6 and 11, Toukura discloses an engine control for a vehicle in which rotation of an engine is transmitted to a driven wheel through a transmission system (column 2, lines 32-34) wherein during engine acceleration variations of engine speed are detected (column 5, lines 8+) and if the variations are more than a value (column 5, lines 34+), then the engine output is restricted by retardation of a crankshaft angle being reduced which will control vibrations of the

Art Unit: 3681

vehicle (keeping engine vibration from transferring to transmission). Inherently, engine or shaft speed is determined by a time interval over a fixed degree of shaft rotation.

As to claim 5, Toukura discloses the variations in engine speed determined by crankshaft variations (angle) and vehicle acceleration.

As to claims 7-9, Toukura discloses change in ignition timing contributing to control of the engine output wherein the time change is feedback to a control for change in the crankshaft retardation angle (Figure 2).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Muto et al ('586). As to claims 1-3, 6 and 11, Muto et al discloses an engine control for a vehicle in which rotation of an engine is transmitted to a driven wheel through a transmission system (column 4, lines 46-49) wherein during engine acceleration variations of engine speed are detected (column 9, lines 55+) and if the variations are more than a positive value, then the engine output is restricted by delay of ignition timing which will control vibrations of the vehicle (keeping engine vibration from transferring to transmission). Inherently, engine or shaft speed is determined by a time interval over a fixed degree of shaft rotation.

As to claim 5, Muto et al discloses the variations in engine speed determined by rotational variation of engine speed and vehicle acceleration.

Art Unit: 3681

As to claims 7-9, Muto et al discloses change in ignition timing controlling engine output wherein the time change ("aop") is feedback to a control to keep the engine variation from exceeding the positive value (column 9, line 65+).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toukura in view of Nakamura et al ('741). Toukura discloses detecting (measuring) engine variation on successive cycles, but does not disclose what type of cycles they are.

Nakamura et al discloses an engine control wherein engine variations are detected in successive cycles of a compression cycle and exhaust cycle.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to detect the engine variations of Toukura in successive cycles of the engine having a compression and exhaust cycle in view of Nakamura et al to detect irregular combustion conditions of the engine in combination with controlling the engine variations.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muto et al in view of Nakamura et al ('741). Muto et al discloses detecting (measuring) engine variation on successive cycles, but does not disclose what type of cycles they are.

Nakamura et al discloses an engine control wherein engine variations are detected in successive cycles of a compression cycle and exhaust cycle.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to detect the engine variations of Muto et al in successive cycles of the engine having a compression and exhaust cycle in view of Nakamura et al to detect irregular combustion conditions of the engine in combination with controlling the engine variations.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 11 and 13-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,701,893. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an engine control having an engine transmitting rotation to driven wheels through a transmission system and detecting during engine acceleration variations in the rotational state of a shaft if the

degree of change in the variation of the shaft is excessive and restricting an engine output if the change is excessive.

Response to Arguments

Applicant's arguments filed April 5, 2004 have been fully considered but they are not persuasive. As to applicant's argument in the appeal brief suggesting that since the problems being solved in the present application and patent ('893) are different, applicant has a right to an invention utilizing the same principles in both. The examiner agrees that applicant has a right to have a patent on the present invention using the same principles as the patent ('893), but that does not mean that a double patent rejection can not be made between the two concerning what is ***claimed*** in both. It seems that applicant is trying to use the disclosure to overcome the double patent rejection when in fact the analysis for a double patent rejection is on the ***claims*** not the disclosure (see MPEP 804). Although different problems are being solved between the present application and patent, the same engine control is being ***claimed*** in which the present application claims are encompassed in the claims of the patent ('893). The examiner suggest applicant file a terminal disclaimer, but if applicant still feels that the double patent rejection should be withdrawn, then applicant is invited to file another appeal brief if this issue makes the present application finally rejected.

Allowable Subject Matter

Claims 10 and 12-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

Art Unit: 3681

limitations of the base claim and any intervening claims and ***filing of a terminal disclaimer as stated in the double patent rejection above.***

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 000-0000) on _____ (Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Shimada et al ('530) is cited as having an engine output reduced upon detection of an abnormal condition of a throttle valve, etc.

-Petzold et al ('401) and Japanese patent 02030934A are cited as having an engine output reduced to control a clutch slip.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 703-305-0921. The examiner can normally be reached on M-Thur 8 AM TO 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Application/Control Number: 10/064,508

Page 9

Art Unit: 3681

Tdl

June 22, 2004


TISHA LEWIS
PRIMARY EXAMINER
AU 3681 6/22/04